

**REMARKS**

Claims 1-3, 6, 8-12, 15 and 17-26 are pending in this application. By this Amendment, claims 1, 6, 12 and 15 are amended and claims 4, 5, 7, 13, 14 and 16 are canceled. No new matter is added. Applicant respectfully requests reconsideration and prompt allowance of the pending claims at least in light of the following remarks.

Applicant appreciates the courtesies shown to Applicant's representative by Examiner Jean-Gilles in the February 26, 2008 personal interview. Applicant incorporates a separate record of the substance of the interview into the following remarks.

Claims 1-26 are rejected under 35 U.S.C. §102(b) over U.S. Patent No. 5,999,932 (Paul). Applicant respectfully traverses the rejection.

In light of comments made during the February 26 interview, Applicant revises independent claims 1 and 12 to incorporate features from various dependent claims (claims 4, 5 and 7).

Regarding the rejection of claim 4, the Office Action alleges that Paul discloses that the at least one predetermined condition is constituted by the message having an attachment, and further alleges that inherently, the predetermined data fields of the e-mail messages are able to contain an attachment. This is not the correct standard for determining anticipation.

As set forth in MPEP §2112 IV, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Rather, to establish inherency, the "extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the things described in the reference, and that it will be so recognized by persons of ordinary skill" (emphasis added). *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999). Inherency, may not be established

by probabilities or possibilities. "The mere fact that certain things may result from a given set of circumstances is not sufficient." *Id.*

The Examiner does not provide rationale or evidence tending to show that an e-mail message necessarily includes an attachment or that an attachment is specified as criteria for determining that a particular e-mail message is likely to be relevant to the user. Accordingly, this feature is not inherent.

Regarding the rejection of claim 5, the Office Action alleges that Paul discloses the at least one predetermined condition is constituted by the message being a forwarded message, in col. 5, lines 20-62, and col. 6, lines 1-29. However, col. 5, lines 20-62, and col. 6, lines 1-29, only describe that "TO," "CC," "BCC," and "SUBJECT" fields are matched with the inclusion list and e-mails are displayed in users outbox. Paul's apparatus updates the inclusion list and does not disclose any aspect of assessing whether the message is a forwarded message or using this as a criteria for selection.

Regarding the rejection of claim 7, the Office Action alleges that Paul discloses the at least one predetermined condition is constituted by the message including a URL, and further alleges that using a URL as a precondition in the context of the invention is "inherent." Again, Applicant asserts that the Examiner fails to provide rationale or evidence tending to show inherency. Rather, the Office Action refers to the capability of having such a feature. Specifically, most e-mails do not include a URL and instead only have e-mail addresses, which do not constitute a URL. Mere capability of performing a function does not meet the standard for establishing inherency.

Because Paul fails to teach each and every feature of independent claims 1 and 12 as amended, these claims and claims dependent therefrom distinguish over Paul.

Regarding claims 8 and 17, the Office Action alleges that Paul discloses the profile data comprising one or more key words or phrases in col. 3, lines 6-19. However, col. 3,

lines 6-19 do not disclose any aspect of key words or phrases. Therefore, claims 8 and 17 are allowable for their dependence on allowable base claims and for the additional features recited therein.

For the foregoing reason, withdrawal of the rejection is respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff  
Registration No. 27,075

Stephen P. Catlin  
Registration No. 36,101

JAO:HXT/amw

Date: February 28, 2008

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 320850**  
**Alexandria, Virginia 22320-4850**  
**Telephone: (703) 836-6400**

DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461
--